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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DWIP N. BANERJEE, RAKESH SHARMA, and
VASU VALLABHANENI

Appeal 2008-004974
Application 10/006,059
Technology Center 2400

Decided: January 15, 2010

Before JOSEPH L. DIXON, JAY P. LUCAS, and DEBRA K. STEPHENS,
Administrative Patent Judges.

STEPHENS, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from a final rejection of claims 1-20 (App. Br. 4). We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We REVERSE.

Introduction

According to Appellants, the invention is a system and method for "debugging network protocol errors using an XML document." (Spec. 2, ll. 6-7). Network data packets are used in generating an XML document that, after analyzed, is used to simulate changes to the data packets (Abst.).

STATEMENT OF THE CASE

Exemplary Claim

Claim 1 is an exemplary claim and is reproduced below:

> 1. A method of performing network protocol simulation using an eXtensible Markup Language (XML) document, the XML document representing network communication exchanges, the network protocol simulation including changes made in the XML document to effect changes in the network communication exchanges, the method comprising the steps of:
>
> generating an XML document using network protocol data packets; and
>
> changing a part of the XML document to perform the network protocol simulation.

Prior Art

| Lienhard | 6,778,863 B1 | Aug. 17, 2004 |
| Slaughter | 6,789,077 B1 | Sep. 7, 2004 |

Rejections

Claims 1-3, 6-8, 11-13, and 16-18 stand rejected under
35 U.S.C. § 102(e) as being anticipated by Lienhard.

Claims 4-5, 9-10, 14-15, and 19-20 stand rejected under
35 U.S.C. § 103(a) as being unpatentable over Lienhard and Slaughter.

ISSUE 1

35 U.S.C. § 102(e): claims 1, 6, 11, and 16

Appellants argue their invention is not anticipated by Lienhard (App.
Br. 5). Specifically, Appellants argue Lienhard does not disclose teach, or
suggest "generating an XML document using network protocol data packets,
and changing a part of the generated XML document to perform network
protocol simulation" (*id.*) (emphasis omitted). Rather, Appellants contend,
Lienhard teaches that "a real process and a simulator use XML documents to
exchange information" (*id.*). Thus, Appellants argue Lienhard does not
teach XML documents are generated from network protocol packets (*id.*).

The Examiner found Lienhard teaches "generating an XML document
using network protocol data packets" (Ans. 4). The Examiner based the
finding on Lienhard's teaching of direct data exchange between a simulator
1 and a real process 3 via a common standard format, such as XML (*id.*).
Further, the Examiner found use of the XML Internet standard suggests a
network protocol is being used (*id.*).

Issue: Have Appellants shown the Examiner erred in finding
Lienhard teaches generating an XML document using network protocol data
packets?

FINDINGS OF FACT (FF)

Lienhard Reference

(1)   "The simulator 1 can be coupled to the real process 3 via one or several interfaces 2" (col. 4, ll. 35-36). The interfaces 2 are bidirectional and enable data transmission between the real process 3 and the simulator 1 (*id.* at ll. 44-45). Both transmissions preferably take place by means of a simple data exchange such as XML documents (*id.* at ll. 47-48). Thus, the process model data is directly transmitted as an XML document from the simulator 1 to the real process 3 (*id.* at ll. 49-50).

PRINCIPLES OF LAW

Anticipation

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)).

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citation omitted). According to the single source rule, all the claim's limitations must be contained in a single reference, *see, e.g., Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001), and the reference "must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter

existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention." *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002) (citations omitted).

ANALYSIS

After considering the totality of the record before us, we find Appellants have shown the Examiner erred in finding Lienhard teaches generating an XML document using network protocol data packets. While we find Lienhard teaches the transmission of an XML document from a simulator 1 to a real process 3 (FF 1), we find that Lienhard fails to teach the XML document is generated using network protocol data packets. We find Lienhard does not disclose, either expressly or inherently, the limitation of generating an XML document using network protocol data packets. Indeed, we find Lienhard does not describe the limitation with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. Therefore, Appellants have persuaded us of error in the Examiner's conclusion of anticipation with respect to exemplary claim 1.

Accordingly, we reverse the Examiner's rejection of independent claim 1 as being anticipated by Lienhard. Since independent claims 6, 11, and 16 were argued on the same basis as claim 1, we also reverse the rejection of independent claims 6, 11, and 16, as being anticipated by Lienhard. Claims 2-3, 7-8, 12-13, and 17-18 depend from independent claims 1, 6, 11, and 16, respectively. Thus, for the reasons discussed above

with regard to the underlying base claims (i.e., claims 1, 6, 11, and 16), we reverse the Examiner's rejection of claims 2-3, 7-8, 12-13, and 17-18.

ISSUE 2

35 U.S.C. § 103(a): claims 4, 5, 9, 10, 14, 15, 19, and 20

Claims 4, 5, 9, 10, 14, 15, 19, and 20 depend from independent claims 1, 6, 11, and 16, respectively. As found above with regard to exemplary claim 1, we are persuaded by Appellants' arguments that Lienhard fails to teach generating an XML document using network protocol data packets. We further find the Examiner has not presented any arguments or evidence as to why Slaughter would have cured the deficiency of Lienhard. Thus, we find neither Lienhard nor Slaughter, taken alone or in proper combination, disclose, teach, or suggest generating an XML document using network protocol data packets as recited in independent claims 1, 6, 11, and 16. Therefore, we reverse the obviousness rejection of claims 4, 5, 9, 10, 14, 15, 19, and 20.

CONCLUSION

Appellants have shown the Examiner erred in finding claims 1-3, 6-8, 11-13, and 16-18 are anticipated by Lienhard.

Additionally, Appellants have shown the Examiner erred in rejecting claims 4, 5, 9, 10, 14, 15, 19, and 20 under 35 U.S.C. § 103(a) as being obvious over Lienhard and Slaughter.

<div align="center">DECISION</div>

The Examiner's rejection of claims 1-3, 6-8, 11-13, and 16-18 under 35 U.S.C. § 102(e) as being anticipated by Lienhard is reversed.

The Examiner's rejection of claims 4, 5, 9, 10, 14, 15, 19, and 20 under 35 U.S.C. § 103(a) as being obvious over Lienhard and Slaughter is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

<div align="center">REVERSED</div>

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